

REMARKS

Claims 20, 22, 25-27, and 30-50 are pending in the current application. Claims 20, 22, 25-27, and 30-50 currently stand rejected, and claims 20 and 30-33 have been amended. Reconsideration and allowance of claims 20, 22, 25-27, and 30-50 are respectfully requested in light of the preceding amendments and following remarks.

Improper Finality of March 26, 2009 Office Action

The Examiner has made the March 26, 2009 Office Action final, without identifying a basis for the finality of that action. Applicants respectfully submit that the March 26, 2009 Office Action cannot be made final at least because Applicants' amendments of March 2, 2009 did not necessitate the finality. See MPEP § 706.07(a) ("a second or any subsequent action on the merits in any application . . . will not be made final if it includes a rejection, on newly cited art, . . . of any claim not amended by applicant or patent owner in spite of the fact that other claims may have been amended to require newly cited art.") Here, the Examiner has newly cited US Pat Pub 2001/0028789 to Uchide to reject claims 22, 34, 38, 42, 46, and 50, which were not amended in the March 2 response or at any point in this round of prosecution. Thus, the March 26, 2009 Office Action may not be made final under § 706.07(a). Withdrawal of the finality of the March 26, 2009 Office Action and entry of this amendment under 37 C.F.R. § 1.111 are respectfully requested.

Claim Rejections – 35 U.S.C. § 103

Claims 20, 25-27, 30-33, 35-37, 39-41, 43-45, and 47-49 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over US Pat 6,483,983 to Takahashi et al. (“Takahashi”) in view of US Pat 6,009,234 to Taira et al. (“Taira”). Claims 22, 34, 38, 42, 46, and 50 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Takahashi in view of Taira and US Pat Pub 2001/0028789 to Uchide (“Uchide”). Applicants respectfully traverse these rejections for the reasons detailed below.

With respect to claim 20, the Examiner maintains the rejection over Takahashi and Taira, applying only the latter to teach “a menu data file” including a “group of thumbnail pictures being stored together as a block of menu data.” Applicants respectfully reiterate that Taira does not teach or suggest a group of thumbnail pictures stored together as a block in a file. Rather, the following detailed discussion of Taira indicates that video and audio data will always be stored with thumbnail pictures in any file in Taira. Further, Applicants note that claim 20 has been clarified to recite that a “menu data file includ[es] **only** data for a group of thumbnail pictures,” such that no video or audio data may be stored with the thumbnail pictures in a file as Taira does.

Where Taira discloses thumbnail pictures stored in a file, it is a disk information file (76) storing, in a menu data video area (84), several cells (90) each including video, sub-picture data, or audio data. See Taira, Fig. 5, elements 76, 84, 90; Col. 11, ll. 39-54. Taira never discloses or suggests that

all cells (90) in any file (76) store only sub-picture data, as would be required to inherently meet the claim in the manner applied by the Examiner. Indeed, where Taira discusses sub-picture data specifically, it is to contemplate the situation where **no** sub-picture data is included in file (76). See Taira, Col. 12, ll. 15-16 (no sub-picture data); Col. 11, l. 51-54 (audio-only title). Thus, Taira never necessarily has only sub-picture data within its information file, and thus does not inherently meet the claim language. See MPEP § 2112 ("To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is **necessarily present** in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" Quoting In re Robertson, 169 F.3d 743, 745 (Fed. Cir. 1999) (emphasis added))

Further, Taira strongly suggests that its information file (76) will always include audio and/or video data. Specifically, Taira states "video data cell 105, . . . comprises a plurality of groups of pictures (GOP) in each of which a control pack (DSI) 92, a **video** pack 93, a sub-picture pack 95 and an **audio** pack 98 **are combined**. The structure of the **video cell 105 is substantially the same as that of the menu cell 90**. The video data 102 consists of movie data, audio data, sub-picture data, etc." in Column 12, lines 49-54. Coupled with the disclosure in Taira that cells (90) are in a menu data **video** area that are

presented onscreen, Taira indicates that even individual cells 90 include non-thumbnail data.

Lastly, Applicants wish to reemphasize Taira must include only thumbnail data in its information file (76) in order to meet claim 20. Contrary to the Examiner's suggestion in response to Applicants' previous arguments, even if some sub-picture data is grouped in information file (76), this does not meet the claim limitation requiring a "menu data file including **only data for a group of thumbnail pictures.**" As discussed above, Taira never necessarily discloses where all data within any file is thumbnail data but instead strongly suggests that any file including sub-picture data will also include audio and/or video data. Thus, Taira lacks the "menu data file" including only data for a "group of thumbnail pictures being stored together as a block of menu data" for which Taira alone is applied.

Takahashi and Uchide admittedly do not cure the above differences between claim 20 and Taira. Because Takahashi, alone or in combination with Taira and Uchide, does not teach or fairly suggest each and every element of claim 20, these references cannot anticipate or render obvious this claim. Claims 30-33 are equally allowable over Takahashi at least for being amended to recite a similarly unique thumbnail image storage scheme as claim 20. Claims 22, 25-27, 34-42, and 43-50 are allowable at least for depending from an allowable base claim. Withdrawal of the rejections to claims 20, 22, 25-17 and 30-50 under 35 U.S.C. § 103(a) is respectfully requested.

CONCLUSION

Accordingly, in view of the above amendments and remarks, reconsideration of the objections and rejections and allowance of each of claims 20, 22, 25-17 and 30-50 in connection with the present application is earnestly solicited.

Pursuant to 37 C.F.R. §§ 1.17 and 1.136(a), Applicant(s) hereby petition(s) for a two (2) month extension of time for filing a reply to the outstanding Office Action and submit the required \$490.00 extension fee herewith.

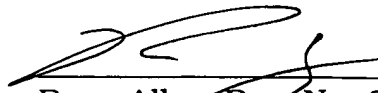
Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Ryan Alley at the telephone number of the undersigned below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

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By



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